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EXAMINER
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NASH, LASHANYA RENEE

ART UNIT	PAPER NUMBER
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2153

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/881,671	<b>Applicant(s)</b> CHERN, VINCENT	
	<b>Examiner</b> LaShanya R. Nash	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This action is in response to a Request for Continued Examination filed 08 November 2006. Claims 1-18 are presented for further consideration. Claims 1, 13-16 and 18 are original. Claims 2-12, and 17 were previously presented. Claims 19-26 are cancelled.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 November 2006 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-18 have been fully considered but they are not persuasive.

In considering the Applicant's arguments the following factual remarks are noted:

- (I) Applicant contends that Qua fails to teach each and every element of the claim (i.e. a connection to a first server prior to a recording step on a second server).

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(II) Applicant contends that it is not obvious to modify the sequence steps of Qua with disclosures in Gupte to arrive at Applicant's invention.

(III) Applicant contends that Gupte fails to disclose the easy access to voice attachments or audio files; therefore no motivation exists in Gupte to modify Qua.

In considering (I), Applicant contends that Qua fails to teach each and every element of the claim (i.e. a connection to a first server prior to a recording step on a second server). However, Applicant fails to address Qua in combination with Gupte as applied by Examiner to show these aforementioned limitations. Examiner asserts, as stated in the previous Office Action (pages 3-4), Qua expressly discloses connecting to a first server (i.e. adjunct server) and second server (i.e. email server) so as to record and subsequently distribute audio files. Examiner additionally asserts that Gupte discloses first connecting to an email server (i.e. paragraphs [0014]-[0016]), so as to select an option to send an audio file to an email recipient (i.e. provide action menu) prior to the actual recording of the voice message (paragraph [0031]; Figure 5). Examiner asserts that the teachings of Gupte were cited so as to evidence that it was well known in the art at the time of invention to connect to an email server prior to recording an audio message, and therefore would have been an obvious modification to the method as disclosed by Qua to first connect to an email server to provide an option to send an audio message prior to the message being recorded. As a result, Examiner maintains rejections as set forth below in the Office action.

In considering (II), Applicant contends it is not obvious to modify the sequence steps of Qua with disclosures in Gupte to arrive at Applicant's invention. Examiner respectfully disagrees. As address with discussing (I), Gupte expressly teaches first connecting to an email server for making a decision to forward an audio note before the audio note is recorded, so as to compose an audio attachment for a reply email. Audio attachments and reply emails where well known electronic messaging features in the art at the time of the invention, as previously evidenced by Gupte, and subsequently would have been obvious modifications to the system of Qua. As discussed in the previous Office Action (pages 4-6), Qua expressly discloses distributing audio note files via an electronic mailing system as an audio attachment to an electronic mail. In turn, this specific functionality of Qua suggests a motivation to modify the system so as to also support recording and storing audio notes for reply emails (i.e. after connecting to first server). Although Qua does not expressly disclose the exact configuration of Applicant's invention (i.e. a connection to a first server prior to a recording step on a second server), the reference also does not explicitly nor implicitly suggest that this aforementioned configuration (i.e. Qua modified with Gupte) would render the system inoperable (i.e. Qua does not suggest that connecting to the email server 160 interferes or prohibits recording/storing function of the audio note taking mechanism 129). Applicant also fails to discuss any further evidence to support their assertion that Qua would be inoperable or unable as modified by Gupte (Remarks, page 10). Therefore, Examiner asserts that it is obvious to modify the sequence steps of Qua with

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disclosures in Gupte to arrive at Applicant's invention. As a result, Examiner maintains rejections as set forth below in the Office action.

In considering (III), Applicant contends that Gupte fails to disclose the easy access to voice attachments or audio files; therefore no motivation exists in Gupte to modify Qua. Examiner respectfully disagrees. Examiner asserts that Gupte discloses providing easy access to selected emails or other electronic communications via a wireless device (Gupte paragraph [0006], lines 6-10). In addition, Gupte expressly discloses that access to these aforementioned electronic communications is inclusive voice attachments and audio files (Gupte paragraph [0016] and paragraph [0031]). Therefore, Examiner further asserts that motivation exists in Gupte to modify Qua. As a result, Examiner maintains rejections as set forth below in the Office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2,4-6,8-10,13-14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua (US Patent 6,222,909) in view of Gupte et al. (US**

**Patent Application Publication 2001/0034225), hereinafter referred to as Qua and Gupte respectively.**

In reference to claim 1, Qua explicitly discloses a method for employing an audio note taking mechanism. The disclosed mechanism enables a user of a wireless device to store audio files (i.e. audio notes) and subsequently distribute them to other recipients over a wireless network via email (column 1, lines 40-49; Figure 1; and Figure 3). Qua discloses:

- A method for sending an audio file to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device, (column 1, lines 40-49; column 2, lines 49-59) comprising:
  - Communicatively connecting to a first server (i.e. adjunct server for audio note taking mechanism) over the wireless communications network, (column 3, lines 8-12 and column 4, lines 12-22);
  - Selecting an option to send the audio file to the email recipient, (column 5, lines 46-52 and column 3, lines 59-66);
  - Communicatively connecting to a second server (i.e. email server) over the wireless communications network, (column 2, line 49 to column 3, line 7 and Figure 1);
  - Recording the audio file on the second server, (column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43); and

- Sending the audio file to the email recipient, (column 5, lines 52-62).

Although the audio note taking method disclosed by Qua explicitly shows the limitations regarding the steps of the claimed invention, the reference does not expressly disclose the aforementioned steps as sequentially consistent with the claimed invention (i.e. **FIRST** connecting first to email server). However, Qua discloses “numerous modifications and alternative embodiments of the invention would be apparent to those skilled in the art...without departing from the spirit of the invention.” (column 8, lines 14-22). Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to modify the sequence of the method disclosed by Qua, so as to first connect to an email server, as further evidenced by Gupte.

In an analogous art, Gupte discloses a method involving communicatively connecting to a **first** server (i.e. email server system) via a wireless device, in order to access email messages including audio file attachments, (paragraph [0014], lines 1-16; paragraph [0016], lines 1-6). One of ordinary skill in the art would have been so motivated to implement this modification so as to provide easy access to selected emails or other electronic communications via a wireless device (Gupte paragraph [0006], lines 6-10).

In reference to claim 18, Qua discloses a method for sending a voice message (i.e. audio note) to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device, (column 1, lines 40-49;



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column 2, lines 49-59) comprising: selecting an option to send a voice message (i.e. audio note) to the email recipient, (column 5, lines 46-52 and column 3, lines 59-66); recording the voice message on an interactive voice response server (i.e. adjunct server for audio note taking mechanism), (column 3, lines 8-12 and column 4, lines 11-22); recording the voice message on an interactive voice response server, (column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43; column 6, lines 32-35; and column 6, line 64 to column 7, line 19); and sending the voice message in an attachment to an email to the email recipient, (column 5, lines 52-62).

Although the audio note taking method disclosed by Qua explicitly shows the aforementioned limitations regarding the steps of the claimed invention, the reference does not expressly disclose the aforementioned steps as sequentially consistent with the claimed invention (i.e. **FIRST** connecting first to email server). In addition, Qua does not disclose expressly dialing a phone number for communicatively connecting to an email server in a data packet connection over the wireless communication network. However, Qua discloses that "numerous modifications and alternative embodiments of the invention would be apparent to those skilled in the art...without departing from the spirit of the invention" (column 8, lines 14-22). Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to modify the sequence of the method disclosed by Qua so as to first connect to an email server; and dialing a phone number for communicatively connecting to an email server, as further evidenced by Gupte.

In an analogous art, Gupte explicitly discloses a method for providing email messages, including audio file attachments, to a wireless communications device, (paragraph [0014], lines 1-16; paragraph [0016], lines 1-6). This method involves the user of a wireless device communicatively connecting to a **first** server (i.e. email server system) via employing the wireless device to dial a phone number to subsequently connect to the email server (i.e. email server system) (paragraph [0018], lines 1-11). Gupte further discloses establishing a data packet connection between the wireless device and the email server, for subsequent access to an email message (paragraph [0022], lines 1-23). This modification would have been obvious because one of ordinary skill in the art would have been motivated to extend the functionality of the audio note taking method to provide automatic access to the email server system with only a single dialing action by the user, thereby increasing ease of use (Gupte paragraph [0017], lines 8-12).

In reference to claim 2, Qua and Gupte show the audio note taking method wherein communicatively connecting to a first server further comprises: dialing a phone number for connecting to the first server (i.e. email server system) using the wireless communication device, (Gupte paragraph [0018], lines 1-11 and Figure 1); and establishing a data packet connection (i.e. data channel) between the wireless communication device and the first server, (Gupte paragraph [0022], lines 1-8 and Figures 1-2).

In reference to claim 4, Qua and Gupte show the audio note taking method wherein the step of selecting an option to send the audio file further comprises: viewing a received email file on the wireless communication device, (Gupte paragraph [0005], lines 6-11); selecting an option to respond to the received email file, (Gupte paragraph [0031], lines 6-9); and selecting an option for attaching the audio file to the response to the received email file, (Gupte paragraph [0031], lines 9-11).

In reference to claim 5, Qua and Gupte show the audio note taking method wherein the step of communicatively connecting to a second server (i.e. adjunct server for audio note taking mechanism) further comprises: transmitting a signal to the second server indicating a pending connection with the wireless communication device, (Qua column 3, lines 8-13 and column 3, lines 22-26); terminating the connection with the first server, (Gupte [0023], lines 1 –5); and establishing an audio connection between the wireless communication device and the second server, (Qua column 4, lines 11-22 and column 6, lines 32-36).

In reference to claim 6, Qua and Gupte show the audio note taking method wherein the step of transmitting a signal to the second server (i.e. adjunct server for audio note taking mechanism) further comprises sending user identification information (i.e. identification code) to the second server, (Qua column 6, lines 32-36).

In reference to claim 8, Qua and Gupte show the audio note taking method wherein the step of recording the audio file further comprises: providing an audio input through the wireless communication device, (Qua column 3, lines 22-26); and storing the audio input as an audio file on the second server (i.e. adjunct server for audio note taking mechanism, (Qua column 4, lines 40-43).

In reference to claim 9, Qua and Gupte show the audio note taking method further comprises providing the user with at least one option, the option selected from the group consisting of: re-recording the audio file, canceling the recording, and sending the audio file to the email recipient, (Qua column 3, lines 59-66 and column 6, line 64 to column 7, line 19).

In reference to claim 10, Qua and Gupte show the audio note taking method wherein the step of sending the audio file to the email recipient further comprises: transmitting a signal (i.e. audio file) to the first server (i.e. email server) indicating that the audio file is ready to be sent; attaching the audio file to an electronic mail file; and sending the electronic mail file to the email recipient, (Qua column 5, lines 46-64 and Figure 3).

In reference to claim 13, Qua and Gupte show the audio note taking method wherein the first server (i.e. email server system) comprises an email server, (Gupte paragraph [0016], lines 1-13 and Figure 1).

In reference to claim 14, Qua and Gupte show the audio note taking method wherein the second server (i.e. adjunct server for audio note taking mechanism) comprises an interactive voice response server, ((column 3, lines 22-26; column 4, lines 19-25; and column 4, lines 40-43; column 6, lines 32-35; and column 6, line 64 to column 7, line 19).

In reference to claim 16, Qua and Gupte show the audio note taking method wherein the audio file comprises a .wav file, (Gupte paragraph [0016], lines 4-6 and paragraph [0031], lines 6-12).

In reference to claim 17, Qua and Gupte show the audio note taking method wherein the step of sending the audio file to the email recipient comprises the step of sending a hyperlink (i.e. pointer or URL) to the audio file stored on the second server (i.e. adjunct server for audio note taking mechanism), (Gupte paragraph [0033], lines 7-13 and Qua column 3, lines 59-66).

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view Oakes et al. (US Patent 6,205,342), hereinafter referred to as Oakes.**

In reference to claim 3, Qua and Gupte teach the audio note taking method wherein the step of selecting an option to send the audio file further

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comprises the step of selecting an option for attaching the audio file an email file, (Qua column 5, lines 46-52 and column 3, lines 59-66). However the references fail to teach expressly selecting an option for composing a new email file. Nonetheless, this limitation was well known in the art at the time of the invention, as further evidenced by Oakes. Therefore, one of ordinary skill in the art would have readily recognized the advantages to implementing this modification.

In an analogous art, Oakes teaches a user of a wireless device (i.e. cellular phone) entering a message creation mode in order to compose an initial email file (i.e. text message), (column 3, line 63 to column 4, line 12 and Figure 4). One of ordinary skill in the art would have been so motivated to accordingly modify the audio note method so as to increase the ease of generating email files (i.e. text message) for wireless device users, thereby increasing convenience (Oakes column 1, lines 6-10).

**Claims 7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view Gibson et al. (US Patent Application Publication 2002/0016174), hereinafter referred to as Gibson.**

In reference to claim 7, Qua and Gupte disclose the audio note taking method that comprises disconnecting from the first server (i.e. email server system) (Gupte paragraph [0023], lines 1-5). However, the references fail to disclose storing a set of state information on the wireless communication device, the state information comprising a status of an interaction between the wireless communication device and

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the first server for allowing the wireless communication device to return to the same state in the first server that existed prior to the step of terminating the connection.

Nonetheless, one of ordinary skill in the art would have readily recognized the advantages associated with implementing this modification to the audio note taking method, as further evidenced by Gibson.

In an analogous art, Gibson discloses a method involving web-enabled wireless devices switching between an Internet connection and telephone connection at the request of the user, (paragraph [0053], lines 1-10 and Figure 5). Gibson further discloses interruption processing that saves state information (i.e. base address) of the original connection on the wireless device in order to re-establishes communication to the associated entity, (paragraph [0053], lines 11-21). The aforementioned modification would have been obvious because one of ordinary skill in the art would have been motivated to provide a mechanism for switching back and forth between voice communication and data communication to users of wireless devices, thereby increasing convenience (Gibson paragraph [0035], lines 1-5).

In reference to claim 11, Qua and Gupte teach the audio note taking method comprises disconnecting from the first server (i.e. email server system) (Gupte paragraph [0023], lines 1-5). However, the references fail to teach expressly reconnecting to the first server (i.e. email server system). Nonetheless, one of ordinary skill in the art would have readily recognized the advantages associated with this modification to the audio note taking method, as further evidenced by Gibson.

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In an analogous art, Gibson teaches a method involving web-enabled wireless devices reconnecting access to voice communication and data communication such as the Internet, in order to directly access web content by using a telephone number format (paragraph [0014], lines 1-11; paragraph [0035], lines 1-5, and paragraph [0023], lines 1-7). This modification would have been obvious because one of ordinary skill in the art would have been motivated to provide an efficient mechanism for selecting between voice and data modes to users of wireless devices (i.e. wireless phones), (Gibson paragraph [0035], lines 1-5).

In reference to claim 12 Qua, Gupte, and Gibson show the audio note taking method wherein the step of reconnecting to the first server comprises: providing the user with a plurality of options selected from the group consisting of: listening to a second audio file stored on the second server, and reconnecting to the first server (i.e. email server system), (Qua column 7, lines 1-17; column 6, lines 32-35; Gibson paragraph [0036], lines 5-17; and Figure 3).

**Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Qua and Gupte as applied to the claims above, and further in view Segur (US Patent 6,212,550), hereinafter referred to as Segur.**

In reference to claim 15, Qua and Gupte show the audio note taking method involving connecting to a first server (i.e. email server system) and a second server (i.e. adjunct server for audio note taking mechanism). However, the references do not show



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a method wherein the first and second servers are connected by common platform means. Nonetheless, this modification would have been obvious to one of ordinary skill in the art at the time of the invention, as further evidenced by Segur.

Segur discloses a multi-format communications client-server that subsequently combines audio file storage and email distribution on a common platform, (column 1, lines 58-65; column 2, lines 27-55, and Figure 2). One of ordinary skill in the art would have been so motivated to accordingly modify the audio note taking method so as to access one centralized server, thereby decreasing time associated with accessing multiple message sources (Segur column 1, lines 58-65 and column 1, lines 24-27).

### ***Conclusion***

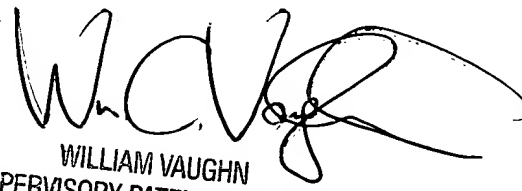
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R. Nash whose telephone number is (571)272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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LaShanya Nash  
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March 13, 2007



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